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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/680,098

10/08/2003

Akihiko Nagata

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EXAMINER

WILLIAMS, ROSS A

ART UNIT

PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/680,098

Applicant(s)

NAGATA ET AL.

Examiner

Ross A. Williams

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21, 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application |
| 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

DETAILED ACTION

Response to Amendment

Claim 21 has been amended.

Claims 21 and 21 are currently pending.

The Applicant has amended claim 21, thus the rejection of this claim under 35 U.S.C. 112 second paragraph has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu (US 5,362,068).

Regarding claim 21, Liu discloses a conventional game cartridge that is know in the art, wherein the game cartridge has a program memory unit 142 that contains the characteristics of the game, such as the order and duration of particular events, the time when a particular playing unit or background scenery should appear, and the movement of the playing units. The graphics memory unit (143) is divided into different storage locations, each containing background music information or data corresponding to the bit patterns that make up particular playing unit or background scenery. For example, data in first and second storage locations of the graphics memory unit (143) may

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contain the bit pattern of the face or whole body of a respective one of two playing units.

When the CPU (10) is activated to start the game, the CPU (10) receives commands from the internal memory unit (13), thereby enabling the former to gather program data from the program memory unit (142). Based on data from the program memory unit (142), the CPU (10) retrieves the faces or whole bodies of the playing units from the graphics memory unit (143) so as to show the same on the VDU (11) (Lui 1:21 – 48).

Thus the system inherently has a storage routine that stores game information including a game program when the CPU executes commands from the internal memory and retrieves data or faces or whole bodies of the playing units from the graphics memory unit. The graphics memory unit has storage locations that store or register background music that is played during the execution of the game instructions (Lui 1:32 – 37, 3:25 – 31). This background music data is stored or registered on the game console unit when the CPU of the game console unit retrieves the data from the graphics memory unit to be executed and then displayed on the VDU.

Regarding claim 22, The Microsoft Encarta Dictionary defines ringing as “stated loudly and unmistakably”. With this definition in mind the sound of the musical data that Lui describes would have to be loud enough and unmistakable to the user to hear in order for the music to enhance the presentation of the game.

Response to Arguments

Applicant's arguments filed 10/12/2006 have been fully considered but they are not persuasive.

The In response to applicant's arguments, the recitations "*portable terminal*", "*registration*" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The Applicant argues that "nothing in Lui teaches or suggests that there are plural sets of background music." The Examiner respectfully disagrees and directs the applicant's attention to Lui Col 1: lines 32 – 37, which states "*The graphics memory unit (143) is divided into different storage locations, each containing background music information or data corresponding to the bit patterns that make up a particular playing unit or background scenery.*" Thus as one can readily see Lui discloses having more than one music data set stored, wherein each music data set is stored in a separate location in memory.

The Applicant also argues that since Lui teaches that a single music data set corresponds to a given background or activity, that nothing is selected, due to the fact that music has a predetermined relationship to the background or activity. The Examiner respectfully disagrees. Although the music may be have a predetermined relationship with the background or activity, the music can still be viewed as "selected". When the game console's CPU is executing the game program and grabs game

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program code (i.e. distribution to the console device) from the memory of the game cartridge, the musical data set that corresponds to that background or activity is also selected.

As per the Applicants statement that "music that plays loudly is not a ringing melody". The Examiner respectfully disagrees and points out that music heard by an individual can be considered ringing and having melody as per the applicants claimed invention. The Examiner has not particularly found a specific definition in the specification included or excluding what may or may not be considered a "ringing melody".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross A. Williams whose telephone number is (571) 272-5911. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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TC3700